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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,387	01/14/2004	Dane Scarborough	LEV1107	5442
7590 10/13/2004				
STEPHEN M. NIPPER DYKAS, SHAVER & NIPPER, LLP P.O. BOX 877 BOISE, ID 83701			EXAMINER GUADALUPE, YARITZA	
			ART UNIT 2859	PAPER NUMBER

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,387

Applicant(s)

SCARBOROUGH, DANE

Examiner

Yaritza Guadalupe McCall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13 is/are rejected.
- 7) ☒ Claim(s) 7-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/5/2004, 5/11/2004</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on May 5, 2004 and May 11, 2004 have been fully considered by the examiner.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 7 of U.S. Patent No. ( US 6,701,635 ). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in the instant application is fully disclosed and is covered by the U.S. Patent since the Patent and the application are claiming common subject matter.

For example, the U.S. Patent claims a marking device for use with a tape measure of the type having a housing with an opening therein through which a portion of a tape having a measuring indicia is extendable in a first direction with the remainder of the tape being coiled in said housing comprising an enclosure attached to said housing for containing said marking device, an impression wheel for applying a mark to a surface, and a marking substance applicator for applying a marking substance to the rim, all of which are clearly disclosed by the subject matter as claimed in the present application.

4. Claims 1 – 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 13 of U.S. Patent No. ( US 6,698,104 ). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in the instant application is fully disclosed and is covered by the U.S. Patent since the Patent and the application are claiming common subject matter.

For example, the U.S. Patent claims a marking tape measure comprising a housing for containing a measuring tape therein, a measuring tape having measuring indicia thereon and extendable through a tape blade aperture, and a marker attaching to said housing at said front wall and comprising an impression wheel for rotationally applying a mark to a surface to be marked, all of which are clearly disclosed by the subject matter as claimed in the present application.

5. Claims 1 – 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 10 of U.S. Patent No. ( US 6,637,125 ). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in the instant application is fully disclosed and is covered by the U.S. Patent since the Patent and the application are claiming common subject matter.

For example, the U.S. Patent claims a marking tape measure comprising a housing for containing a measuring tape and a marking device therein, a tape having measuring indicia thereon and extendable through a tape opening in a first direction with the remainder of the tape being coiled within said housing, and a marking device for applying a mark to a surface and connected to said housing and configured to extend from said housing adjacent said second longitudinal surface, all of which are clearly disclosed by the subject matter as claimed in the present application.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 – 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cimorell et al. ( US 6,612,046 ) in view of Kolody ( US 3,646,885 ).

In regards claims 1 and 2, Cimorell et al. discloses a marking tape measure ( 10 ) comprising a housing ( 22 ) for containing a measuring tape ( 12 ) therein, said housing comprising a front wall ( 30, 120 ) defining a tape blade aperture ( 34 ); said measuring tape (12)

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having measuring indicia ( 18 ) thereon, said measuring tape ( 12 ) extendable through said tape blade aperture (34) ( See dashed lines in Figure 1 ); and a marker / pointed end ( 174 ) attached to said housing ( See Figure 2 ). Cimorell et al. further discloses at least one marking indicia applicator / inker ( 180 ) for applying a marking indicia ( ink ) to said marker, wherein said marking indicia applicator / inker (180) is configured to transfer said marking indicia to said marker ( 174 ), wherein said marker subsequently transfers said marking indicia to said surface to be marked thereby creating said mark.

In regards claim 13, Cimonell et al. clearly discloses said marker ( 174 ) being integral to said housing ( See Figure 2 ).

Cimorell et al. does not discloses said marker comprising at least one wheel as stated in claim 1. Cimorell et al. does not discloses said wheel being disposed on an axle as stated in claim 3 and having a generally circular circumference defining a rim as stated in claim 4. Cimorell et al. does not discloses said rim width being generally perpendicular to the rotation of said wheel, and said rim width defining a circumvolving channel as stated in claims 5 and 6.

With respect to the wheel as stated in claims 1 and 3 - 6 : Kolody discloses a marking apparatus (10) having a marker ( 13 ) comprising at least one wheel attached to a housing ( 11 ) by an axle ( 14 ) for rotationally applying a mark to a surface to be marked, said wheel being generally circular and having a circumference defining a rim, said rim having a width ( See Figures 1 and 2 ) generally in a perpendicular direction with respect to the rotation of the wheel

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and defining a circumvolving channel, said wheel being also in direct contact with at least one marking indicia applicator ( 16 ) for applying a marking indicia ( ink ) to said wheel ( See Figure 4 ), wherein said marking indicia applicator ( 16 ) is configured to transfer said marking indicia to said wheel, wherein said wheel subsequently rotationally transfers said marking indicia to said surface to be marked thereby creating said mark ( See Column 1, lines 62 – 67 ).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Cimonell et al. by replacing the pointed end marker with a wheel marker as taught by Kolody in order to provide a low friction marker that will slide over the working surface creating a continuous marking with minimum chance of scratching or damaging the surface.

***Allowable Subject Matter***

8. Claims 7 – 12 and 14 – 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 16 – 17 are allowed.



***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are considered of relevance to the present application :

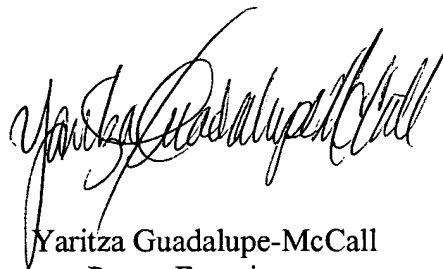
- a. O'Malley ( US 4,989,326 )
- b. Bryant et al. ( US 5,038,492 )
- c. Ruffer ( US 5,815,939 )
- d. Hester ( US 6,789,329 )
- e. Chen ( US 5,505,133 )
- f. Frank et al. ( US 3,783,785 )
- g. Hogue ( US 4,372,049 )

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe-McCall whose telephone number is (571) 272-2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yaritza Guadalupe-McCall', is positioned above the printed name.

Yaritza Guadalupe-McCall  
Patent Examiner  
Art Unit 2859

YGM  
October 7, 2004